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10/786,279	02/24/2004	Mark Banister	MEDIPACS 04.02	2485
27667	7590	08/14/2009	EXAMINER	
HAYES SOLOWAY P.C. 3450 E. SUNRISE DRIVE, SUITE 140 TUCSON, AZ 85718			BARTON, JEFFREY THOMAS	
			ART UNIT	PAPER NUMBER
			1795	
			NOTIFICATION DATE	DELIVERY MODE
			08/14/2009	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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### Office Action Summary

**Application No.**

10/786,279

**Applicant(s)**

BANISTER, MARK

**Examiner**

Jeffrey T. Barton

**Art Unit**

1795

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1.5-11, 14-33, 36 and 37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1.5-11, 14-33, 36 and 37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/06)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Amendment***

1. The amendment filed on 27 April 2009 does not place the application in condition for allowance.

***Status of Rejection Pending Since the Office Action of 30 March 2009***

2. The rejection is withdrawn due to Applicant's amendment.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1, 5-11, 14-33, 36, and 37 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claim 1 at lines 2-7, there is no support for the limitation "a plurality of flexible layers in stacked order including a flexible base sealing layer, a flexible thin film battery layer, a flexible thin film photovoltaic layer to produce electricity, an illuminator layer, electrical circuitry, a protective surface, . . .". There is no clear disclosure of electrical

circuitry being specifically provided between an illuminator layer and a protective surface in the specification as originally filed, as required in the amended claim.

In addition, in claim 1 at lines 12-13, there is no support for the limitation "whereby to selectively charge the battery and/or power the illuminator". No description of selective charging of the battery or powering the illuminator is present in the specification as filed.

Claims 5-11, 14-33, 36, and 37 depend from claim 1 and therefore include all limitations thereof. These claims are rejected on the same grounds.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1, 5-11, 14-33, 36, and 37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1 at lines 7-9, the claim recites ". . . a protective surface, an adhesive, and a removable covering for said adhesive" as part of the claimed plurality of flexible layers required to be "in stacked order", but then immediately recites "applied to said protective surface or base sealing layer". The phrasing of the claim makes it unclear whether the adhesive, removable covering, or other layers are required to be provided in the claimed order, or whether different sequences are contemplated.

In addition, there is no clear antecedent basis for "the electrical circuit" as recited in line 11 of claim 1. It appears Applicant intended to recite "the electrical circuitry" at

this location, but such recitation would also be unclear, since the circuitry is limited to placement between the illuminator layer and the protective surface, and it is unclear how circuitry so limited can be connected to the battery layer or photovoltaic layer as claimed or provide the claimed intended use of selectively charging the battery, since there are intervening layers positioned between the battery and photovoltaic layers and the circuitry.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 1, 5-11, 14-33, 36, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murasko et al (US 2002/0159245; hereinafter Murasko '245) in view of Yamamura (JP 62-106671 with English Abstract), Murasko (US 2001/0035716;

hereinafter Murasko '716), Murasko (US 6,203,391; hereinafter Murasko '391), Curtin (US 6,160,215), and Kakinote et al (JP 59-217991; partial translation provided, full translation to follow)

Regarding claim 1, Murasko '245 teaches a fully contained solar powered laminated electrical tape illuminated device comprising stacked layers including a substrate 202 that can be plastic; a photocell 208 (i.e., a photovoltaic that is illuminated by the sun); a device 204, such as a thin film battery, for storing electricity produced by the photocell 208; a source of illumination 206; electrical circuitry 214 for connecting the components; and, as a protective surface, a light transmissive, electrically insulating material (see paragraphs 0023 to 0025). This laminated system reads on a "tape" in that Murasko '245 discloses adhesive backing for these devices. (Paragraph 0028) Note also that Murasko '245 teaches that the electroluminescent devices of Murasko '716 and Murasko '391 are suitable for use within their devices. (Paragraph 0030) The electrical circuit is disclosed as including light sensing switches that provide for selectively charging the battery and/or powering the illuminator. (Paragraph 0027)

Regarding claim 6, the substrate required in the structure of Murasko '245 inherently has a finite thermal conductivity, and will dissipate heat at a corresponding rate. The structure inherently meets the limitations of this claim.

Regarding claims 7-9, Murasko '245 discloses light-sensing switches (Paragraph 0027), which sense ambient light levels, and actuate a switch operable to turn the lamp on or off. Such switches read on the claims.

Regarding claim 11, it is the Examiner's position that the electrical circuitry in the device of Murasko '245 inherently prevents electric current drain through the photocell.

Regarding claim 14, Murasko '245 discloses a transparent front electrode of the EL lamp. (Paragraph 0027)

Regarding claim 15, Murasko '245 discloses transparent non-electrical layers. (Paragraph 0025, "light-transmissive" coatings)

Regarding claim 17, the electroluminescent lamp of Murasko '245 emits electromagnetic radiation having a frequency, which reads on the claim.

Regarding claims 18-21 and 36, Murasko '245 discloses the electroluminescent lamp comprising an organic light emitting diode. (Paragraph 0021)

Regarding claims 23 and 24, a metallic substrate, as disclosed in paragraph 0025 of Murasko '245 would be reflective, and oriented to reflect light through the opposite surface of the device.

Regarding claims 25 and 26, the organic polymers listed in paragraph 0021 are fluorescent and luminescent.

Regarding claim 27, insulating substrates are dielectric (Paragraph 0025).

Regarding claim 30, leads 214 (Paragraph 0027) are electrodes on the electroluminescent device, contacts to the power supply, and connection between both, meeting the limitations of the claim.

Regarding claim 33, Murasko '245 discloses using plural devices to provide a signal. (Paragraph 0028)

Relevant to claims 5, 10, 31, and 32, Murasko '245 teaches using the laminated devices for signs, billboards, or other illuminated designs or images. (Paragraph 0028) In a different embodiment, the reference also teaches signal receivers/transmitters as claimed (Paragraph 0036; microprocessor control) and a second EL lamp connected to the power supply, which can be illuminated at different times than the first lamp. (Paragraph 0037) Such a second lamp requires a separate, alternative power outlet (i.e. from battery) and inlet (i.e. to second EL lamp) as required by claim 5.

Murasko '245 also teaches using an adhesive on the protective surface or base sealing layer to affix the devices onto surfaces. (Paragraph 0028)

Regarding claim 1, Murasko et al do not explicitly teach a removable covering over the adhesive, specifically flexible components and device as claimed, the thin film solar cell overlying the thin film battery, or the device having the claimed order of layers. Regarding claim 16, Murasko et al do not teach a clear adhesive. Within the cited embodiment of Figure 2, Murasko et al does not explicitly disclose an alternative power inlet and outlet as claimed in claim 5, the transmitters and receivers claimed in claim 10, or the edge to edge assembly/lamination required by claims 31 and 32.

Curtin teaches providing solar cells having an adhesive layer over an outer protective surface, and a removable backing over a clear adhesive layer that allows the cell to be affixed to any desired substrate. (Figure 6; Abstract; Column 4, lines 16-19)



Murasko '716 teaches an electroluminescent device that is flexible. (Paragraph 0030) And Murasko '391 specifically discloses flexible substrates for EL devices. (Column 1, lines 15-17; Column 2, lines 57-63)

Yamamura et al teaches reduction in the number of parts of a laminated solar battery device and simplified assembly achieved by disposing a charge storage device (Capacitor) on the non-light receiving surface of a thin-film solar cell assembly. (Constitution section of Abstract; Figure 1)

Kakinote et al is cited for teaching a conventional configuration of a solar powered illumination device. Kakinote et al provides a translucent illuminator (7) overlying the thin-film photovoltaic layer (11) and other underlying layers, with the translucent illuminator positioned adjacent transparent protective layer 1. (Figures 1 and 2; provided partial translation)

Regarding claim 1, it would have been obvious to one having ordinary skill in the art to modify the device of Murasko '245 by including a removable backing on the adhesive layer, as taught by Curtin, because a skilled artisan would have recognized the advantage of such a backing in that it allows easier handling of the devices prior to affixing on a surface. (i.e. no adhesion until desired, no need to apply an adhesive immediately prior to mounting)

Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify the device of Murasko '245 by disposing the thin film charge storage device on the non-light receiving surface of the thin film solar cell, as taught by Yamamura, because Yamamura teaches that such a

design reduces the number of parts required and simplifies the assembly of the device.  
(Purpose section)

In addition, as to the claimed order of layers, Kakinote et al demonstrate that it is conventional to position the illuminator layer (7) on the light-receiving side of the photovoltaic cell between the cell (11) and the circuitry (e.g. 2) that is adjacent protective layer 1. Selection of such a known configuration of layers in a solar-powered illumination device amounts to a matter of design choice, obvious to one having ordinary skill in the art. Only the expected result of a functioning illumination device would have resulted from the combination, and full expectation of success would be present in the combination, as the references are concerned with solar powered illumination devices. The teachings of Yamamura et al and Kakinote et al demonstrate the obviousness of selecting the instantly claimed sequence of layers.

Furthermore it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify the device of Murasko '245 by selecting a flexible electroluminescent device of Murasko '716 and flexible substrates taught by Murasko '391, because Murasko '245 suggests using the electroluminescent devices of Murasko '716 and Murasko '391 for this purpose (Paragraph 0030), and selection from among known flexible substrate materials for electroluminescent devices would have been obvious to one having ordinary skill in the art.

Based on the teachings of the prior art as applied above, all claim limitations are taught, except for explicit teachings of flexibility in the respective photovoltaic, battery, and circuitry, and overall device. It is the Examiner's position that thin film

semiconductor, metal, and dielectric films that form the thin film photovoltaic and battery layers and leads 214 are "flexible", inasmuch as none of these materials has sufficient thickness to impart rigidity when disposed on a flexible substrate. The overall laminated structure will be flexible when disposed on a flexible substrate.

Specific to claim 16, it would also have been obvious to one having ordinary skill in the art to use a clear adhesive, as taught by Curtin, because it would allow adhesion of the device on the interior side of windows and the like, increasing the protection of the devices from damage while still allowing light to reach the solar cell and the light from the EL lamps to be visible from the exterior.

Regarding claim 5, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of the embodiment of Figure 2 of Murasko '245 by connecting a second lamp to a battery, as taught in Paragraph 0037 of Murasko '245, because it would increase the illumination provided by the system and enable a wider variety of display designs powered by a single cell/battery unit. Such a system would have lower manufacturing costs than two lamps powered by separate cell/battery units, providing additional motivation for such an arrangement.

Regarding claim 10, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of the embodiment of Figure 2 of Murasko '245 by using a computer to control the illumination performed by the system, because this would enable desirable complex illumination patterns, such as those described in paragraph 0036, for creative and attractive displays.

Regarding claim 22, any material that transmits light and has a refractive index other than 1 reads on this claim. The polyester film substrate of Murasko '391 meets the limitation.

Regarding claim 28, conventional polyester film substrates, as used by Murasko '391, are smooth.

Regarding claim 29, the device as claimed includes the removable backing, which is at an exterior surface. Curtin teaches a paper backing (Column 4, lines 7-16), and paper is textured.

Regarding claims 31 and 32, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place plural adhesive devices of the embodiment of Figure 2 of Murasko '245 adjacent each other in making a sign, billboard or other display design, depending on what shape or design is desired. Adjacent placement of these devices reads on the limitations of these claims.

Regarding claim 37, this claim is directed to formation of the claimed product by a specified process, and does not further limit the claimed structure. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) As there is no evident structural difference

between the structure of the prior art and that claimed, the claim is rejected on the same grounds as claim 1.

### ***Response to Arguments***

10. Applicant's arguments with respect to the previous rejection have been considered but are moot in view of the new ground(s) of rejection. Where they apply to the rejection made above, they are addressed below.

Applicant's argument seems to focus on the absence of a teaching of a plurality of flexible layers in stacked order including the instant base sealing layer, battery layer, photovoltaic layer and illuminator layer in Murasko '245 in particular and the previously cited art in general. The Examiner has taken the position above that the prior art renders such a sequence of layers obvious, based on the teachings of the prior art (including newly-cited Kakinote et al; JP 59-217991) In the rejection made above, it is the combined teachings of the references that are relied upon. Nonobviousness is not shown by pointing out that Murasko '245 lacks the claimed structure. Clearly, Murasko '245 does not teach the entirety of the device claimed by Applicant.

Applicant's citation of purported advantages of the claimed device described in the specification is not persuasive because they bear no clear relationship to the claimed structure.

***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Jeffrey T. Barton whose telephone number is (571)272-1307. The examiner can normally be reached on M-F 9:00AM - 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen can be reached on (571) 272-1342. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey T. Barton/  
Examiner, Art Unit 1795  
10 August 2009